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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,102	12/27/2000	Thomas J. Schubring	1100.1111101	6260

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EXAMINER

PATEL, RAMESH B

ART UNIT

PAPER NUMBER

2121

DATE MAILED: 05/03/2004

(O)

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/749,102	SCHUBRING ET AL.
	Examiner Ramesh B. Patel	Art Unit 2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 March 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-56 is/are pending in the application.
- 4a) Of the above claim(s) 21-52 and 55 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-20,53,54 and 56 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-56 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

1. Claims 1, 3-20, 53-54 and 56 are presented for examination. Claim 2 has been canceled due to the amendment filed 3/22/2004. Claims 21-52 are withdrawn due to the restriction requirement as being nonelected claims and claims 1, 3-20, 53-54 and 56 elected without traverse. Claim 55 is withdrawn from further consideration due to the invention is directed towards independent or distinct from the invention originally claimed as stated reason given in the paragraph # 2 below.
  
2. Newly submitted claim 55 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 55 is directed towards a replaceable brake pad assembly for use with a system that receives the brake pad assembly which is classified in class 192, subclass 107 which is independent and/or distinct from claims 1, 3-20, 53-54 and 56.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 55 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

**Election/Restrictions**

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Art Unit: 2121

- I. Claims 1, 3-20, 53-54 and 56, drawn to a replaceable media assembly, classified in class 210, subclass 85.
  - II. Claims 21-38, drawn to a replaceable filter assembly for use with an HVAC system that receives the replaceable filter, classified in class 700, subclass 276.
  - III. Claims 39-45, drawn to a method for controlling a system, classified in class 700, subclass 19.
  - IV. Claims 46-52, drawn to a method of upgrading/modifying a program of a controller of a control system, classified in class 700, subclass 87.
4. The inventions are distinct, each from the other because of the following reasons:
- Inventions I, II, III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions claims 1, 3-20, 53-54 and 56 are related to a replaceable media assembly, while claims 21-38 are related to a replaceable filter assembly for use with an HVAC system that receives the replaceable filter; claims 39-45 are related to a method for controlling a system and claims 46-52 are related to a method of upgrading/modifying a program of a controller of a control system.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, III and IV and vice a versa, restriction for examination purposes as indicated is proper.
7. During a telephone conversation with Mr. Tufte, Brian N. (Reg. No. 38,638) on 4/26/2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1, 3-20, 53-54 and 56. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-52 and 55 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. The rejection to claims 11 and 16 under 35 USC 112, second paragraph is withdrawn due to the amendment.

10. The rejection to claims 1 and 3-20 under 35 U.S.C. 102/103 is withdrawn and the new rejection is given based on the merits.

**Claim Rejections - 35 U.S.C. § 102**

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-7 and 14-20 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Friedman (US Patent 6,078,845).

As to claims 1 and 56, Friedman teaches the invention including a replaceable media assembly for use with a system that receives the replaceable media, the system having a controller, the replaceable media assembly comprising: replaceable media is taught as the carrier for transferring items or media (see, figures 3-8); storage means for storing information, said storage means fixed to the replaceable media, said storage

means containing a microcontroller, the microcontroller including a software upgrade for the system is taught as the carrier or replaceable media having storage means for storing information which are fixed with the carrier or media and containing microcontroller including a software or program for modifying or editing or updating the data or program (see, figures 3-8 and 10-11 and col. 2, lines 10-57); and communication means for providing communication between the storage means and the controller of the system, the communication means facilitating the transfer of the software upgrade to the system (see, figures 10-11 and col. 2, line 44 to col. 3, line 3 and col. 6, lines 35-61).

As to claim 2, Friedman teaches the replaceable media assembly wherein the information stored in the storage means is used by the controller of the system to adjust the operation of the system (see, figures 10-11 and col. 6, lines 35-61).

As to claims 3-4, Friedman teaches the wherein the information stored in the storage means relates to the replaceable media and to the performance of replaceable media (see, figures 3-8 and col. 2, lines 10-57).

As to claims 5-6, 14, Friedman teaches the wherein the storage means comprises a memory and programmed microcontroller and the information stored in the storage means comprises a program (see, figures 3-8 and abstract and col. 2, lines 10-57).

As to claim 7, Friedman teaches the wherein the information stored in the storage means includes a time value that relates to the recommended replacement interval of the replaceable media assembly (see, figures 10-11 and col. 2, lines 10-57 and col. 6, lines 35-61).

As to claims 15-17, Friedman teaches the, wherein the program causes the micro-controller to communicate with the controller of the system and to pass a number of performance parameters related to the replaceable media to the controller of the system and to provide a software upgrade to the controller of the system (see, figures 10-11 and col. 6, lines 35-61).

As to claims 18-20, Friedman teaches the wherein the information stored in the storage means includes a serial number or model number, a sound file, a graphics file, an advertisement file, or a user instruction set of the replaceable media and the controller of the system reads the serial number or model number from the storage means and determines the compatibility of the replaceable media with the system (see, figures 10-11 and col. 6, lines 35-61).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (US Patent 6,078,845) in view of Leblanc et al. (US Patent 6,341,670).

As to claims 8 and 10-13, Friedman teaches all limitations as stated in claims 1 and 56 above; however, Friedman fails to teach that the replaceable media comprises a brake pad and the information stored in the storage means includes an expected pressure drop value that relates to the expected pressure drop through the replaceable media when the replaceable media is clean or when the media is dirty, adjusts the operation of the system to accommodate the pressure drop and wherein the controller of the system reads the maximum pressure drop value and provides a notification to change the filter when the system detects that the maximum pressure drop value is reached.

Leblanc teaches a brake wear managing system which includes pad and monitors pressure in the system and provide the information which stored in the storage means includes an expected pressure drop value that relates to the expected pressure drop through the replaceable media when the replaceable media is clean or when the media is dirty, adjusts the operation of the system to accommodate the pressure drop and wherein the controller of the system reads the maximum pressure drop value and provides a notification to change the filter when the system detects that the maximum pressure drop value is reached (see, abstract and figures 1-6 and col. 5, lines 16-59

and col. 8, lines 13-30). It would have been obvious to a person of ordinary skill in the art at the time the was made to modify the teachings of Freidman with the teaching of Lablanc because this modification would provide Friedman's teaching with the enhanced capability controlling the system through efficient monitoring of the system.

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman (US Patent 6,078,845) in view of Hoague (US Patent 6,186,140).

As to claim 9, Friedman teaches all limitations as stated in claims 1 and 56 above; however, Friedman fails to teach that the replaceable media comprises a filter.

Hoague teaches a filter assembly which includes a filter element and a memory device (see, abstract and figures 1-5). It would have been obvious to a person of ordinary skill in the art at the time the was made to modify the teachings of Friedman with the teaching of Hoague because this modification would provide Friedman's teaching with the enhanced capability of providing a replaceable media having various device or assembly with memory devices for providing information to and from controller to assembly for improving efficiency of the system by replacing the correct assembly.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramesh B. Patel whose telephone number is 703-308-6673. The examiner can normally be reached on M-Th; 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ramesh B. Patel  
Primary Examiner 4/21/04  
Art Unit 2121

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